

Serial No. 10/523,645

Docket No. ZEN-0001

Amendment dated April 26, 2007

Reply to Office Action of February 13, 2007

### **REMARKS/ARGUMENTS**

Claims 9-14 are pending in this application. By this Amendment, claims 1-8 are canceled without prejudice or disclaimer, new claims 10-14 are added, and the title is amended. Currently, claims 9-14 are before the Examiner for consideration on their merits.

In review, claims 9-14 are primarily based on the use of the composition for accelerating estrogen secretion for treating or preventing a disorder associated with menopause. Claim 9 was originally filed with the application, which was not addressed in the Office Action. Dependent claims 10-14 are added.

The preceding amendments and the following remarks are believed to be fully responsive to the outstanding Office Action and are believed to place the application in condition for allowance.

The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks as set forth hereinbelow.

### **Rejection under 35 U.S.C. 102(b)**

The Examiner rejected claims 1-3, 5-8 under 35 U.S.C. 102(b) as being anticipated by WO 02/47702 to Kim et al. (Kim). The basis for this rejection was that Kim teaches a composition containing the claimed extracts and a method of obtaining the extract.

In light of the cancellation of claims 1-8, it is submitted that Kim cannot anticipate independent claim 9 for the simple reason that Kim does not teach the claimed treatment method. Claim 9 is directed to a novel use of *Platycodi Radix* extract and/or *Cynanchum wilfordii* extract to accelerate the secretion of estrogen.

As described throughout the specification, in particular, from line 4 in page 17 to line 19 in page 22 of the specification, the subject matter of claims 9-14 is the new use of the composition containing one or more of the group of *Platycodi Radix* extract, *Cynanchum wilfordii* extract and *Phlomis umbrosa* extract.

The present inventors have discovered that the composition of the present invention allows an animal to promote the secretion of estrogen for the treatment of menopause-related disorders.

Kim does not disclose, teach or even suggest the method of claim 9 for the acceleration of the secretion of estrogen by administering a composition containing an active ingredient as one or more of *Cynanchum wilfordii* extract and *Platycodi Radix* extract, wherein a disorder associated with menopause is treated or prevented.

Kim discloses a composition that is used to induce the secretion of insulin-like growth factor-1(IGF-1) not estrogen. Even, *assuming arguendo*, that the composition of Kim is the same as the claimed composition, the issue before the Examiner is whether Kim teaches using the claimed composition to accelerate the secretion of estrogen for treatment of menopause disorders. This use is clearly not taught or suggested by Kim.

Accordingly, the present inventions of claims 9-14 are not anticipated by Kim and the rejection under 35 U.S.C. § 35 U.S.C. § 102(b) must be withdrawn.

**Rejection under 35 U.S.C. 103(c)**

The Examiner also rejected claims 1-8 under 35 U.S.C. 103(a) as being obvious over Kim. Here, the Examiner admits that Kim did not teach the presence of *Phlomis umbrosa* with the composition containing the extracts of *Platycodi Radix* and *Cynanchum wilfordii*. In spite of this deficiency, the Examiner takes the position that it would be obvious to include *Phlomis umbrosa* with the other claimed extracts since the Abstract of Kim recognizes *Phlomis umbrosa* as one of the group in the composition.

Regardless of whether Kim suggests combining *Phlomis umbrosa* with the other extracts, Kim still fails to suggest the method of claim 9 in terms of treatment of disorders related to menopause via the acceleration of the secretion of estrogen via the administering of the claimed composition to an animal. Regardless of whether Kim suggests the use of *Phlomis umbrosa* in combination with either or both of the *Platycodi Radix* and *Cynanchum wilfordii* extracts, the method of claim 9 is still not suggested.

The remaining question is whether there is any motivation to lead one of skill in the art to modify Kim so as to arrive at the claimed features. There is no reason to support a conclusion that the method of claim 9 is an obvious modification of Kim since Kim is totally unrelated to the aim of the claimed features. Any further allegation of obviousness could only be predicated

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on Applicants' own teachings, and such an allegation is the impermissible use of hindsight to support a rejection under 35 U.S.C. § 103(a). This type of a rejection could not be sustained on appeal, and because of this, there is no legitimate basis to make a rejection under 35 U.S.C. § 103(a).

Since claim 9 is not suggested by Kim, its dependent claims 10-14 are also patentable by reason of their claim dependency.

To summarize, claims 9-14 are supported by the descriptions from line 4 in page 17 to line 19 in page 22 of the Specification and original claim 9 as filed. Kim cannot anticipate claim 9 since Kim does not disclose, teach or suggest the method for accelerating of the secretion of estrogen by administering the claimed composition. Thus, claims 9-14 are not anticipated by Kim. Lastly, claims 9-14 are not obvious over Kim since there is no basis to modify Kim and arrive at the features claimed.

In view of the foregoing amendments and remarks, the Applicant respectfully requests the reconsideration and reexamination of this invention and the timely allowance of the claims 9-14.

### CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. Favorable consideration and prompt allowance are earnestly solicited.

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If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, **Daniel Y.J. Kim**, at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,  
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